

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIK COELINGH and JONAS EKMARK

Appeal No. 2004-1170
Application 10/063,951

ON BRIEF

Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

REMAND TO THE EXAMINER

This application is remanded to the examiner under the authority of 37 CFR 1.196(a) and MPEP § 1211 for action in accordance with the following comments.

1) A review of the file of the present application reveals the presence of two amendments after final, one filed October 2, 2003 and designated Paper No. 10, and another filed with the

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reply brief on January 9, 2004 (which amendment has not been entered on the filewrapper). Neither of these amendments has been properly acknowledged by the examiner and appellants have not been informed of the status (i.e., entry or non-entry) of these amendments. Thus, we REMAND the application for the examiner to properly treat the two amendments after final.

2) The filewrapper of this application also lists, as Paper No. 8, an Information Disclosure Statement filed October 2, 2003. However, we find no such document in the record and no comment by the examiner concerning any such document. Clarification of the status of this paper is requested.

3) In both the final rejection (Paper No. 5) and the examiner's answer (Paper No. 11) the examiner has rejected appellants' independent claims 1 and 11 under 35 U.S.C. § 102(b) as being anticipated by Sigl (U.S. Patent No. 5,794,735). In each instance, the examiner has urged that the Sigl patent discloses all of the features set forth in appellants' claims 1 and 11, e.g., in the Abstract, Figure 1, lines 30-59 of col. 2, lines 60-67 of col. 2, and lines 4-45 of col. 3. Notwithstanding appellants' request to do so, the examiner has made no effort to

indicate which specific elements disclosed in the Sigl patent correspond to and anticipate the various elements set forth in claims 1 and 11 on appeal, or to clearly explain how the elements of Sigl interact so as to define a vehicle control system like that in claim 11 or a method as in claim 1 on appeal.

The Manual of Patent Examining Procedure (MPEP) § 1208 requires, for each rejection under 35 U.S.C. § 102, that the examiner's answer, or single prior action incorporated therein, shall explain why the rejected claims are anticipated or not patentable under 35 U.S.C. § 102, "pointing out where all of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection." The examiner's answer in this case, with its broad references to the Abstract, Figure 1, and lengthy portions of the patent disclosure of Sigl, does not comply with either the spirit or substance of the foregoing requirement of pointing out exactly where in the applied prior art reference all of the specific limitations recited in the rejected claims are to be found. Thus we find it necessary to REMAND this application to the examiner for clarification of this ground of rejection.

4) With regard to the examiner's rejection of claims 8 and 18 under 35 U.S.C. § 103(a) based on Sigl and Fukada, we note that the examiner's statement and explanation of this rejection has not changed since the first Office action (Paper No. 3, mailed January 31, 2003). More particularly, the examiner has consistently urged with respect to claims 8 and 18, i.e., in Paper No. 3, Paper No. 5 and the examiner's answer (Paper No. 11), that "Sigl does not include the wheel angle," and contended that Fukada "teaches it in column 3, lines 48-51." Following these statements, the examiner has concluded that "[t]herefore, it would have been obvious to one of ordinary skill in the art to combine the aforementioned references in order to control the motor vehicle." The problem with this rejection is that appellants have pointed out on several occasions (i.e., in Paper No. 4, page 8; in the brief, pages 23-26; and in the reply brief, page 2) that claims 8 and 18 define the intended driving demand as including a "yaw rate demand," not a wheel angle demand as the examiner seems to believe and has urged would have been obvious under 35 U.S.C. § 103(a). Since the examiner has not specifically dealt with the actual limitations of claims 8 and 18, nor once

responded to appellants' questions concerning this rejection, we must REMAND the application to the examiner for clarification of the rejection of claims 8 and 18.

5) We also REMAND for the examiner to specifically address appellants' arguments in the brief concerning each of the § 103 rejections. In that regard, we find the examiner's comment in the paragraph bridging pages 6 and 7 of the answer concerning the basic criteria for establishing prima facie obviousness to be of absolutely no assistance in determining why it would have been obvious in this particular case to modify Sig1 in the particular manner urged by the examiner in each of the § 103 rejections so as to result in the subject matter claimed by appellants. On REMAND the examiner should explain, based on teachings derived from the applied references, why it would have been obvious for one of ordinary skill in the art at the time appellants' invention was made to provide the particular features pointed to in the secondary references in the system of Sig1. In doing so, the examiner should keep in mind that a combination of features or elements is not obvious merely because each of the elements is individually known in the art and may be found in an analogous device.

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This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (item D), Eighth Edition, Rev. 1, Feb. 2003. It is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this case.

REMANDED

Charles E. Frankfort

CHARLES E. FRANKFORT
Administrative Patent Judge

Jeff V. Nase

JEFFREY V. NASE
Administrative Patent Judge

Jennifer D. Bahr

JENNIFER D. BAHR
Administrative Patent Judge

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